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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,186	12/15/2000	Claude Brown	800132-15	1344

7590 03/05/2003

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EXAMINER

GELLNER, JEFFREY L

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 03/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/735,186

Applicant(s)

BROWN, CLAUDE

Examiner

Jeffrey L. Gellner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-42 and 44-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 and 44-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The After Final Amendment filed 18 Decemebr 2002 as paper no. 17 has been entered.  
Therefore, Claim 43 has been cancelled.

In view of reconsideration of the prosecution history of US 5,848,492 - PROSECUTION  
IS HEREBY REOPENED. A new ground for rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following  
two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37  
CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

### ***Supplemental Oath***

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37  
CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claim 1-42, 44-46 are rejected as being based upon a defective reissue declaration under  
35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will  
overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in  
the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior  
oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

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***Possible Assignee***

This application (09/735186) is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest in order to support the consent to a reissue application required by 37 CFR 1.172(a). The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR § 3.73 must be submitted in reply to this Office action.

***Proper Support for Amended Claims***

Proper support for Claims 11 and 12, amended in the Preliminary Amendment entered 15 December 2001 as paper no. 3, and newly added Claims 19-43, added in the Preliminary Amendment entered 15 December 2001 as paper no. 3, is lacking as per 37 CFR § 1.173(c). A thorough search of the file did not yield a statement of support accompanying this amendment.

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***Improper Amending of Claims***

Claims 11 and 22 were improperly amended in Amendment C entered 27 February 2002 as paper no. 10 as per 37 CFR § 1.173(d). Specifically, in an amendment the amendment must show by brackets and underlining where the amended claim differs from the claim language in the original patent. That is, regardless of the number of times a claim is amended, the most recent amendment must show the changes in language between the most recent amendment and the original language of the claim in the patent.

***Original Patent Required Prior to Allowance***

The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR § 1.178.

***Claim Rejections under Recapture***

Claims 11-15, 19-21, 22-29, 44, 30-36, 45, 37-43, and 46 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not

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an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

For Claim 11, during the prosecution of 08/958073 (now US 5,848,492) in Applicant's Amendment entered 13 July 1998 as paper no. 4 Applicant argued on page 5, the last para., that the prior art cited by the Examiner "teaches directly away from the subject invention as described and claimed where a flow of superheated steam is delivered to basal leaves to developing grape berries (claim 11) and to raisin grapes or prune plums (claim 14)" (original underlines). Examiner considers the Applicant to have surrendered the language "for defoliating grape vines" and "basal leaves adjacent to developing grape berries" of Claim 11 in US 5,848,492. The deleting of this language in Claim 11 is considered an improper broadening of the claim. see MPEP 1412.02.

For Claims 22, 30, and 37 during the prosecution of 08/958073 (now US 5,848,492) in Applicant's Amendment entered 13 July 1998 as paper no. 4 Applicant argued on page 5, the middle para., that the prior art cited by the Examiner did not disclose or suggest steam "in which substantially all water droplets are removed from the steam before forming superheated steam." Examiner considers Applicant to have surrendered this inventive step. Therefore, all added independent claims (*i.e.*, Claims 22, 30, and 37) must contain this language, or equivalent, to avoid improper broadening of the claims. see MPEP 1412.02.

#### ***Allowable Subject Matter***

Claims 1-10 and 16-19 are allowed over the prior art and will be allowed with the submission of a supplemental oath, proper assignment if needed, and the original patent.

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Claims 1-15, 19-21, 22-29, 44, 30-36, 45, 37-43, and 46 are allowed over the prior art and will be allowed after an amendment to overcome the recapture rejection and with the submission of a supplemental oath, proper assignment if needed, and the original patent.

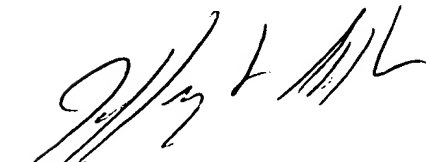
### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Noack ('537), Noack ('939), Southcott, Elliott ('190), Jeffords, McLemore, Peck, Russell, Gamboni et al., Nelken, Sanders, Sijbring, Whitley, Burton, Rees, Hiyama et al., Hoek et al., Thompson, Ziegler, Rajamannan ('111), Rajamannan ('123), Dugast, Chastain, FR 24231132, DE 2738669, SU 1012829, and *Grape Pest Management* disclose in the prior art various devices for defoliating with steam. (These references, cited from US 5,848,492, are cited here to ensure that they are printed on the 1<sup>st</sup> page of the reissue patent.)

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jeffrey L. Gellner whose phone number is 703.305.0053. The Examiner can normally be reached Monday through Thursday from 8:30 am to 4:00 pm. The Examiner can also be reached on alternate Fridays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Peter Poon, can be reached at 703.308.2574. The fax phone numbers for the Technology Center where this application or proceeding is assigned are 703.305.7687, 703.305.3597, and 703.306.4195.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.1113.



Jeffrey L. Gellner